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In re Application of:
Ricky AMOS
Serial No.: 09/995,031
Filed: November 29, 2001
Attorney Docket No.: YOR920010633US1

DECISION ON PETITION

This is a decision in response to the communication filed June 23, 2003. The communication has been treated as a petition under 37 C.F.R. § 1.181, requesting entry of the After Final Amendment filed March 24, 2003.

The petition is **DENIED**.

BACKGROUND

A first Office action was mailed on August 12, 2002, each of the independent claims 1 and 10 were rejected under 35 USC § 102(b) as being anticipated by Noguchi et al. (US Patent No. 6,040,610). Claims 1 and 10 recites a limitation to a Markush grouping containing elements Re, Rh, Ir, Pt and Ru.

A response to the first Office action was submitted on November 18, 2002. In the response, applicant canceled member/element "Pt" from the Markush grouping in each of claims 1 and 10 to overcome the 35 USC § 102(b).

A second Office action was mailed on January 22, 2003, wherein each of independent claims 1 and 10 were again rejected under 35 USC § 102(e) as being anticipated by Maria et al. (Pub. No.: US 2001/0032995 A1), a prior art made of record by the examiner in the first Office action. This Office action was made final.

A proposed after final amendment was filed on March 24, 2003. This amendment proposes canceling member/elements "Ir" and "Ru" from the Markush grouping in each of independent claims 1 and 10 such that the only remaining members/elements within the grouping are "Re and Rh."

An Advisory Action was mailed April 3, 2003, wherein the examiner denied entry of the proposed after final amendment on the grounds that the proposed amendment(s) raise new issues that would require further consideration or search, and/or they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. See M.P.E.P. § 714.13.

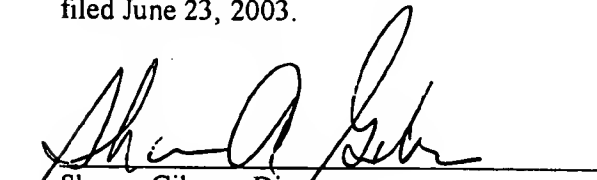
OPINION

In response to the first Office action, applicant could have canceled elements "Ru" and "Ir" from the Markush grouping in addition to canceling element "Pt" but chose not to do so. It appears from the record that applicant elected to delay canceling elements "Ru" and "Ir" until the Office action was made final. By waiting until the Office action is made final, applicant knew or should have known that entry of an amendment after final is not a matter of right and entry of such amendment is limited by the conditions set forth under 37 C.F.R. § 1.116 and M.P.E.P. § 1207. A reference anticipates a claimed invention if it discloses all the structures set forth in the claim(s) and at least one member/element within the Markush grouping. With respect to the Office action mailed on January 22, 2003, the reference to Maria et al. discloses all the structure set forth in each of independent claims 1 and 10 including at least one element "Ru" from the Markush grouping. Hence, the rejection of these claims under 35 USC § 102(e) is proper.

While the proposed canceling of elements "Ru" and "Ir" in the after final amendment does not necessitate a new search by the examiner if it is entered, such entry would clearly raise new issues that will have to be considered by the examiner. Such new issues include a determination of whether and which elements of the Markush grouping in the prior art and the elements remaining in the claims are "equivalents," etc. Accordingly, the argument that the deletion of two elements "Ir" and "Ru" would reduce and simplify the issues for appeal is not convincing since such deletion also would clearly raise new issues. Pursuant to 37 CFR 1.116 and MPEP § 1207, and in view of the above discussions, the refusal of entry of the proposed after final amendment by the examiner is proper and will not be disturbed.

Any request for reconsideration and/or review of this decision must be filed within two months of the mail date of this decision to be considered timely.

The application is being forwarded to the examiner for prompt consideration of the appeal brief filed June 23, 2003.


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